



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

P

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,905	04/06/2001	Mikio Iwase	088941/0193	6507

22428 7590 04/24/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,905

Applicant(s)

IWASE, MIKIO

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on May 10, 2005. Claims 1, and 3-16 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 112

2. Claims 1, and 3-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, 5th paragraph of claim 1, states "-- sending preregistered bank account information to the bank server", the precision of definiteness of this limitation is at issue, it is unclear with whom the account information is preregistered. Given one reading, the account information could be preregistered with the seller, given another; the account registration could be preregistered with the issuing bank of the buyer. The Applicant's specification is somewhat ambiguous on this point. If it is the later interpretation, what does it mean to have a person's own account (a buyer) preregistered with his or her own bank? Is an existing bank account preregistered? Further, the language of the 6th paragraph of claim 1 renders confusion of this term. It is unclear to whom the "seller's" bank information is preregistered? Clarification on this matter is respectfully requested. For further examination purposes, the examiner interprets the claimed limitations in light of this 112 2nd rejection.

Claim Rejections – 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 1, and 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al. US Patent No. 5,946,660 (hereinafter "McCarty") in view of Elgamal US Patent No. 5,671,279.

Claims 1, and 3-16, McCarty discloses a method and a corresponding system for managing a payment between a seller and a buyer using a network, comprising the steps of, at a buyer terminal, accessing a home page of a seller through the network, inputting at the home page of said seller displayed on said buyer terminal, the name and identification data of said buyer into said buyer's terminal connected to said network, said identification data including a password of said buyer, verifying said buyer based on the input name and identification data using a seller's terminal

connected to said network, said verifying including comparing said password of said buyer entered at said buyer terminal with password data stored in a payment management table installed at said seller terminal, displaying at said buyer terminal, for each contract between said buyer and seller a title, an amount due and a due date, said buyer authorizing at said buyer terminal payment as to each contract, sending pre-registered bank account information of said buyer, after said seller's terminal has verified said buyer, directly to a bank server of said buyer via said network using said buyer's terminal, sending pre-registered bank account information of said seller and a payment amount, after said seller terminal has verified said buyer, directly to said bank server of said buyer via said network using said seller terminal, and transferring the payment amount to said seller's bank account, which is indicated by said pre-registered bank account information of said seller, directly from said buyer's bank account, which is indicated by said pre-registered bank account information of said buyer, using said bank server of said buyer (abstract, figs. 5,6, and 9, column 4, lines 15-51, column 7, line 26 thru column 8, line 45, and column 10, line 10 thru column 11, line 50).

McCarty teaches that the seller's updates said payment management table to reflect the payment status information when the payment amount is transferred to said seller's bank account from said buyer's account, the payment managing table is capable of storing data of a plurality of said buyer, and that the seller is a lesser,

the buyer is a lessee, and the payment amount is a rent (abstract, column 10, lines 10-30).

McCarty fails to explicitly teach that the bank account information including an encoded PIN number of said buyer, and the transfer is taking place over a line separate from said network.

Elgamal teaches that the bank account information including an encoded PIN number of said buyer, and the transfer is taking place over a line separate from said network (column 3, line 65 thru column 5, line 32).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of McCarty to include an encoded PIN number of the buyer, and the transfer is taking place over a line separate from said network because, both systems are concerned with security and protecting the parties involved in the transactions. It greatly improves the efficiency of the system by providing a more secure electronic payment system.

McCarty fails to teach the steps of sending said buyer's terminal a reminder to request a payment for an overdue item by using said seller's terminal, and sending said buyer's terminal a confirmation to renew a payment contract if there is less than a predetermined period remaining until the expiry date of the contract by using said seller's terminal.

Official Notice is taken that sending a reminder to request an overdue payment and a confirmation to renew a contract prior to expiration is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of McCarty to include the steps of sending said buyer's terminal a reminder to request a payment for an overdue item by using said seller's terminal, and sending said buyer's terminal a confirmation to renew a payment contract if there is less than a predetermined period remaining until the expiry date of the contract by using said seller's terminal because, it provides the user with a system that is user friendly.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims is mentioned above within the 35 U.S.C. 112 2nd rejection of this office action.

In response to Applicant challenge of taken an official notice to "sending a reminder request of an overdue payment" and "confirmation to renew a contract prior to expiration" are known. A library is a good example of these trivial steps. The newly supplied document "Digital Library" confirms this (see page 17, where libraries send out notifications to renew).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

October 3, 2005